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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/791,914	03/03/2004	Lee-Yin Chee	PJW190	3848
Paul J. Winters 307 Cypress Point Drive Mountain View, CA 94043			EXAMINER CEHC, KENAN	
			ART UNIT 2616	PAPER NUMBER
			MAIL DATE 05/29/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/791,914

Applicant(s)

CHEE ET AL.

Examiner

KENAN CEHIC

Art Unit

2616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 March 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-6 is/are REJECTED.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

1. Claim 2-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takada et al (US 2002/0089931) in view of Shipley (US 5,633,742).

For claim 2, Takada discloses comprising: providing a plurality of packet classes (see section 0008-0011 “service classes” and section 0150 “all the flows”); providing a flag (see section 0166 “discarded flag... class identifier...”), which may be of a first or a second state (see section 0180 “initial value “0” and fig 4b, (8), (c) and section 0184 “1”), for each of the plurality of packet classes (see section 0166 “discarded flag... class identifier...a flow” and Fig 3; 32); generating a packet (see col 4 lines 18-37 “arriving packet”); if the flag of the packet class (see section 0166 “discarded flag...whether a packet belonging to the flow was discarded previously”) of the generated packet (see col 4 lines 18-37 “arriving packet”) is in the first state (see section 0166 “discarded flag...whether a packet belonging to the flow was discarded previously” and section 0180 “initial value “0”), transmitting the packet (see section 0169 “Keeps the pair including the new packet” and section 0205-0206 “Keeps the pair” and section 0154 “sends...packets”). if the flag of the packet class (see section 0166 “discarded flag....whether a packet belonging to the flow was discarded previously”) of the generated packet (see col 4 lines 18-37 “arriving packet”) is in the first state (see section 0166 “discarded flag....whether a packet belonging to the flow was discarded previously” and section 0180 “initial value “0”), changing the flag (see section 0166 “discarded flag....whether a packet belonging to the flow was discarded previously”) of the packet class (see section 0166 “discarded

flag... class identifier...a flow” and Fig 3; 32) of the generated packet to the second state (see fig 4b, (8), (e) and section 0184 “1”).

For claim 3, Takada discloses providing a plurality of packet classes (see section 0008-0011 “service classes” and section 0150 “all the flows”); providing a flag (see section 0166 “discarded flag... class identifier...”), which may be of a first or a second state (see section 0180 “initial value “0” and fig 4b, (8), (e) and section 0184 “1”), for each of the plurality of packet classes (see section 0166 “discarded flag... class identifier...a flow” and Fig 3; 32); generating a packet (see col 4 lines 18-37 “arriving packet”);

if the flag of the packet class (see section 0166 “discarded flag...whether a packet belonging to the flow was discarded previously”) of the generated packet (see col 4 lines 18-37 “arriving packet”) is in the first state (see section 0166 “discarded flag...whether a packet belonging to the flow was discarded previously” and section 0180 “initial value “0”), transmitting the packet (see section 0169 “Keeps the pair including the new packet” and section 0205-0206 “Keeps the pair” and section 0154 “sends...packets”).

if the flag of the packet class (see section 0166 “discarded flag...whether a packet belonging to the flow was discarded previously”) of the generated packet (see col 4 lines 18-37 “arriving packet”) is in the second state (fig 4b, (8), (e) and section 0184 “1”),, not transmitting a packet (see fig 4b (10), (h) and section 0170 “Discards the pair...packet”).

For claim 3, Takada discloses providing a plurality of packet classes (see section 0008-0011 “service classes” and section 0150 “all the flows”);

providing a flag (see section 0166 “discarded flag... class identifier...), which may be of a first or a second state (see section 0180 “initial value “0” and fig 4b, (8), (c) and section 0184 “1”), for each of the plurality of packet classes (see section 0166 “discarded flag... class identifier...a flow” and Fig 3; 32);

generating a packet (see col 4 lines 18-37 “arriving packet”);
if the flag of the packet class (see section 0166 “discarded flag...whether a packet belonging to the flow was discarded previously”) of the generated packet (see col 4 lines 18-37 “arriving packet”) is in the second state (fig 4b, (8), (c) and section 0184 “1”), not transmitting a packet (see fig 4b (10), (h) and section 0170 “Discards the pair...packet”)

For claim 5, Takada discloses (a) providing a plurality of packet classes (see section 0008-0011 “service classes” and section 0150 “all the flows”);

b) providing an injection **flag** (see section 0166 “discarded flag... class identifier...), which may be of a first or a second state state (see section 0180 “initial value “0” and fig 4b, (8), (c) and section 0184 “1”), for each of the plurality of packet classes (see section 0166 “discarded flag... class identifier...a flow” and Fig 3; 32);

(c) generating a packet (see col 4 lines 18-37 “arriving packet”);

(d) if the injection **flag** of the packet class (see section 0166 “discarded flag...whether a packet belonging to the flow was discarded previously”) of the generated packet (see col 4 lines 18-37 “arriving packet”) is in the second state (fig 4b, (8), (c) and section 0184 “1”),

not transmitting a packet (see fig 4b (10), (h) and section 0170 “Discards the pair...packet”)

(e) if the injection flag of the packet class (see section 0166 “discarded flag....whether a packet belonging to the flow was discarded previously”) of the generated packet (see col 4 lines 18-37 “arriving packet”) is in the *first* state (see section 0166 “discarded flag....whether a packet belonging to the flow was discarded previously” and section 0180 “initial value “0”),

transmitting the packet (see section 0169 “Keeps the pair including the new packet” and section 0205-0206 “Keeps the pair” and section 0154 “sends...packets”)

and setting the injection **flag** of the packet class (see section 0166 “discarded flag....whether a packet belonging to the flow was discarded previously”) of the generated packet (see col 4 lines 18-37 “arriving packet”) to the second state (see fig 4b, (8), (e) and section 0184 “1”)

For claim 5, Takada discloses further comprising repeating steps (c) through (e) thereof (see section 0046 “new packets”)

Takada is silent about:

For claim 2, A method for use in verification of a device, testing a device when transmitting a packet

For claim 3,4, and 5 A method for use in verification of a device, testing a device when transmitting a packet and not testing the device when not transmitting a packet.

For claim 2, a method for use in verification of a device.

Shipley from the same or similar field of endeavor discloses a communication network with the following features:

For claim 2, Shipley discloses A method for use in verification (see col 14 25-35 “tests the battery voltage”) of a device (see fig 9, 31), testing a device (see col 14 25-35 “tests the battery voltage”) when transmitting a packet (see col 14 25-35 “tests the battery voltage...transmitted packet”)

For claim 3 and 4, Shipley discloses a method for use in verification (see col 14 25-35 “tests the battery voltage”) of a device (see fig 9, 31), testing a device (see col 14 25-35 “tests the battery voltage”) when transmitting a packet (see col 14 25-35 “tests the battery voltage...transmitted packet”) and not testing the device (see col 14 25-35 “tests the battery voltage...transmitted packet”) when not transmitting a packet (see col 14 25-35 “tests the battery voltage...transmitted packet”).

It would have been obvious to one of the ordinary skill in the art at the time of the invention to modify the system of Takada et al by using the features, as taught by Shipley, in order to provide a monitoring system for communication devices that are battery powered (see columns 3-4).

Response to Arguments

2. Applicant's arguments filed 02/07/2008 have been fully considered but they are not persuasive.

The applicant argues that the combination of certain features of Takada and Shipley is improper.

The applicant uses certain section to argue that could not be combined ("Internet...not a monitoring system....battery powered"). In response to applicant's argument that the combination of Takada and Shipley are improper, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

Furthermore, the applicant argues is not a monitoring system, however the examiner disagrees. The meaning of "monitoring" is "a device or arrangement for observing, detecting, or recording the operation of a machine or system, esp. an automatic control system.: monitor. (n.d.). *Dictionary.com Unabridged (v 1.1)*. If one considers Figures 1-5, it is clear that the system of Takada observes and detects. Even for the most basic operation of the Internet, routing needs to happen where IP addresses need to be detected and observed to accomplish the routing of a packet. Furthermore applicant argues that the "Internet...is not...battery powered". The internet is "a vast computer network linking smaller computer networks worldwide" internet. (n.d.). *Dictionary.com Unabridged (v 1.1)*. The internet does not preclude devices that are battery powered. A battery is merely a source of energy for an electronic device and does not preclude interfacing to the internet.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references

themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Takada discloses a flow control/buffer management system/method, while Shipley discloses a general wireless communication system (see Shipley col 4). So system method of Takada could be implemented on such a general wireless transmitter, where it would be beneficial to provide battery saving features, so that the user of the system can use the device longer (see Shipley col 4).

Applicant further argues that there is “no disclosure of not testing the device for a transmitted device”. However, applicant does not claim this type of language. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., “no disclosure of not testing the device for a transmitted device”) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Takada discloses that packets are either transmitted or discarded based on the flag. So when combined with Shipley, when we have a packet transmitted the test is conducted. Testing is only conducted when a packet is transmitted.

Conclusion

3. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US-2003/0061581 A1	03-2003	Baumgartner et al.
US-2003/0142629 A1	07-2003	Krishnamurthi et al.
US-2004/0223458 A1	11-2004	Gentle, Christopher Reon
US-2006/0209709 A1	09-2006	Kovacevic, Branko D.
US-2007/0008897 A1	01-2007	Denton et al.
US-2007/0147257 A1	06-2007	Oskouy et al.
US-2007/0168748 A1	07-2007	Musoll, Enrique

The above are recited to show test packet generation and test systems.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kenan Cehic whose telephone number is (571) 270-3120. The examiner can normally be reached on Monday through Friday 8:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kwang Yao can be reached on (571) 272-3182. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

KC

/Kwang B. Yao/

Supervisory Patent Examiner, Art Unit 2616